

REMARKS

In the Office Action dated November 17, 2008, the Examiner withdraws claims 10-20 from further consideration as being drawn to a nonelected species, stating that there are no allowable generic or linking claims. The Examiner rejects claims 5-9 under 35 U.S.C. § 112, second paragraph, rejects claims 1-2 and 4-6 under 35 U.S.C. §102(b) and rejects claims 3 and 7-9 under 35 U.S.C §103(a). With this Amendment, Applicants have amended claims 1, 3, 5-7, 9, 15-18 and 20. Claims 4, 10-14 and 19 are canceled without prejudice, and claims 21-23 are added. After entry of this Amendment, claims 1-3, 5-9, 15-18 and 20-23 are pending in the Application. Reconsideration of the Application as amended is respectfully requested.

The Examiner rejects claims 5-9 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicants regard as the invention. In particular, the Examiner states that the “high/reverse clutch” in claims 5 and 6 lacks antecedent basis. Applicants have amended each of claims 5 and 6 to change this feature to the “high/forward clutch,” which has antecedent basis in claim 5. Claim 7 has also been amended to replace an occurrence of “high/reverse clutch” with “high/forward clutch.” Applicants respectfully submit that claims 5-9 are clear and definite and meet the requirements of 35 U.S.C. § 112, second paragraph.

The Examiner rejects claims 1-2 and 4-6 under 35 U.S.C. §102(b) as being anticipated by Ohta et al. (US 2004/0168841) and rejects dependent claim 3 under 35 U.S.C. §103(a) as being unpatentable over Ohta et al. and Hiraku (EP 1 258 658). Applicants have amended claim 1 to include additional structural features and respectfully submit that claim 1 is generic to species A1, A4 and A6. As mentioned, claim 4 is canceled without prejudice. Claims 3 and 5 are amended to clarify antecedent basis to conform to claim 1 as amended. Among other reasons, Applicants respectfully submit that claim 1 and its dependent claims are allowable over Ohta et al. and Hiraku, either alone or in any permissible combination, because they fail to teach or suggest the combination of features claimed, particularly including the second sun gear engaged with the pinion carrier.

In addition, and with respect to dependent claim 6, Applicants respectfully submit that operative mode (f) in Table 3 and FIG. 4 of Ohta et al. is not “a high-speed forward gear.” Accordingly, claim 6 is additional allowable for this reason.

The Examiner rejects claims 7-9 under 35 U.S.C §103(a) as being unpatentable over Ohta et al. and Armstrong et al. (US 6,913,556). Claim 7 has been amended to independent form to include the features of claim 1, 4 and 5 as originally presented. Claim 7 has also been amended to clarify that the first axis described is extending radially relative to the input shaft. Applicants respectfully submit that claim 7 and its dependent claims are allowable over the proposed combination. Applicants respectfully submit that motivation for the proposed combination clearly derived from the subject specification and not from any teaching in the art. The brake/clutch elements in Armstrong et al. are associated with three sets of planetary gears 20, 30, 40 that are required to provide six forward speed ratios and one reverse speed ratio, not a single pinion planetary gear. There is no motivation to look to the significantly different (and non-compact) structure of Armstrong et al. for a teaching to make Ohta et al. more compact. Unlike Armstrong et al., the design of Ohta et al. is already relatively compact. Further, re-arrangement of the elements in Ohta et al. is complicated by the placement of the electric motor. It is difficult to see how Ohta et al. would function with the claimed arrangement given the location of the electric motor 4. For the foregoing reasons, the invention of claims 7-9 is patentable over the cited references.

Claim 9 has been amended to state that the first common axis is located axially closer to the input shaft than the second common axis. In Armstrong et al., the band mechanism for brake 50 is disposed radially outboard of the rearmost one of the planetary gearsets. (See Abstract). Armstrong et al. fails to teach or suggest the features of claim 9 as amended, either alone or in combination with Ohta et al. The invention of claim 9 is thus patentable over the cited references.

Applicants have canceled claims 10-14 and 19 without prejudice, as no generic claim remains in the Application that encompasses the embodiments claimed therein.

Claim 15 and its dependent claims 16-18 remain withdrawn and dependent from claim 1. Claim 15 has been amended to clarify antecedent basis and remove duplicative claim terms based on the amendments to claim 1. Claim 16 has been amended similarly to claim 7 to specify that the first common axis extends radially relative to the input shaft, and claim 17 has been amended similarly to claim 9 to state that the first common axis is located axially closer to the input shaft than the second common axis. Applicants respectfully submit

that claims 15-18 are allowable and should be rejoined based on their dependence from allowable claim 1.

Claim 20 remains withdrawn and dependent from claim 1 so it has been amended to clarify antecedent basis and remove duplicative claim terms based on the amendments to claim 1. Also, a typographical error has been amended therein with respect to the rear ring gear. Applicants respectfully submit that claim 20 is allowable and should be rejoined based on its dependence from allowable claim 1.

Applicants have added new claims 21-23 to this Application, each dependent from claim 7. New claim 21 adds specific locations and connections of dampers Damp1 and Damp2. Claim 22 includes the additional features of original claim 2, and claim 23 includes the features of claim 6 as amended to correct antecedent basis. Applicants respectfully submit that each of these claims is allowable based at least on its dependence from allowable claim 7.

It is submitted that this Amendment has antecedent basis in the Application as originally filed, including the specification, claims and drawings, and that this Amendment does not add any new subject matter to the Application. Consideration of the Application in view of these comments is requested. It is submitted that the Application is in suitable condition for allowance; notice of which is requested.

If the Examiner feels that prosecution of the present application can be expedited by way of an Examiner's amendment, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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